APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,778	04/27/2000	Elliott D. Light	12307/100158	2634

EXAMINER
ZURITA, JAMES H

ART UNIT	PAPER NUMBER
3625	

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DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/559,778	LIGHT ET AL.
	Examiner	Art Unit
	James H Zurita	3625

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 August 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>80-115</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>80-115</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Prosecution History

Applicant filed the present application on 27 April 2000, as a continuation in part of application 09/167873, filed 7 October 1998, now US patent 6,092,053, issued on 18 July 2000.

A first Office Action of 18 June 2003 rejected claims 1-79 as unpatentable over Peckover, WO 97/26612-A1, international publication date of 24 July 1997, in view of an article by Robert Greene, "Online College Applications, Pushing Out Paper", Sep 1, 1997, St. Louis Post - Dispatch; St. Louis, Mo.

On 3 September 2003, Applicant cancelled claims 1-79 and added claims 80-115.

A final rejection of 19 November 2003 rejected claims 8-119 as being unpatentable over Peckover (US 6,119,101) in view of *Walker* (US 5794207).

On 5 August 2004, Applicant presented a request for Continuing Examination. Applicant did not amend claims 80-115.

Applicant's response of 5 August 2004 was found to be non-compliant since the claims did not contain a complete listing of all the claims.

Applicant filed an additional response on 20 August 2004 that included a complete listing of all claims. Applicant did not amend claims 80-115.

Response to Request for Reconsideration

The present Office Action is a response to Applicant's request for continued Examination of 5 August 2004.

Claims 80-115 are pending and will be examined. The claims are unchanged from claims first rejected on 19 November 2003.

Priority

Again, the Examiner acknowledges applicant's claim to priority to Application 09/167873, filed 7 October 1998, issued on 18 July 2000 as US Patent 6,092,053.

As previously requested, in order to clarify the record, the Examiner respectfully requests the Applicant identify where in the prior applications the features of the present invention are first disclosed. It is not clear whether applicant has introduced and claims patentable distinction. For example, In the priority document, applicant refers to customers (in the specification), consumers (in the claims) and merchants. In the instant application customer/ consumer is a "data subject" and merchant is a "data recipient." It is not clear whether applicant has introduced and claims patentable distinction based on these terms.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 80-115 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Peckover (US 6,119,101) in view of *Walker* (US Patent 5794207).

The term *data repository* will be given its broadest reasonable interpretation to

mean a collection of information about a computing system[1] such as a database and

database management software (data repository software). Peckover discloses the use

of collections of information about his computing systems.[2] See, for example,

references to databases and collections of information concerning object server, agent

system, agent managers and others, Figs. 1-10 and related text.

The descriptive material (for example, "data subject", "data recipient", "network

communication device") does not distinguish the claimed invention from the prior art in

terms of patentability. For purposes of applying prior art the term "data subject" will be

interpreted to read on patrons, buyers, clients, shoppers, purchasers, users,

consumers, consumers, a party to a transaction, etc. The term "data recipient" will be

interpreted to read on merchants, sellers, providers, users, a party to a transaction, etc.

The terms "network communication device" will be interpreted to read on any

type of device that might be used to connect a client node to a network in a client/server

network architecture. The types of clients may include personal computers,

workstations, telephones, dumb and intelligent programmable devices, wireless

devices, PDA's. Users on client machines may use a client to search in or access

server databases, select, search, request searches, download files and information, and

generally interact with one or more servers on a network.

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[1] Definition of Repository, MICROSOFT Computer Dictionary.

The term "network communication device software" will be interpreted to read on any client-side software that identifies a client node to server-side software on a network, such as a cookie. See, for example, Col. 6, lines 26-32.

Please note that Peckover discloses that a party may alter roles and that a party may invoke transactions. Peckover discloses at least the following:

Manage persistence – includes hardware and software that manage storage such as one would find in data repositories such as databases). Data stored may be gathered by the system (for example, Col. 25, line 35-Col. 26, line 38, Fig. 9A-9C and related text). See also references to system history data Fig. 2 and related text Fig, 3B for persistence functions, which manage data repository functions for various objects in Peckover's system. For client-side persistence, Peckover discloses the use of cookies (for example, See, for example, Col. 6, lines 26-32). A server may check a cookie against a database to verify whether a customer is registered, using well-known techniques.

Manage communications and messages including hardware and software that (a) connect the parties to the network and each other (b) manage access (authorization and registration) to computer systems and sub-system (c) send and receive data among various parties at one or more network nodes. Peckover discloses the use of unique identification numbers (for example, Col. 18, line 30-Col. 19, line 32) and passwords (applicant's passphrase) for example, Fig. 11 and related text, Col. 27, line 50-Col. 28, line 49).

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[2] Definition of Repository, MICROSOFT Computer Dictionary.

Manage interactions over networks such as the Internet (for example, Col. 5, line

12-52), cable, satellite links and others (for example, Col. 38, line 53-67).

Manage client/server functions – includes hardware and software related to

Human/Machine interfaces, using computer languages such as HTML (for example,

Col. 8, line 9-67). See also references to browser software usable on each party's

machine (applicant's network communication device software). When invoked,

browsers perform a party's client-side activity such as translating information to/from

different native computer languages, send and receive information to/from other nodes

on various networks. Browsers permit users to interact with networks and each other.

Manage logging, gather and store transaction information (for example, Col. 15,

line 10-63). See also references to log functions, whereby Peckover stores records of

activities (claims 88, 90 and related medium and system claims), and transactions for

each party as in Fig. 6 and related text, Col. 21, line 13-67, Fig. 7 and related text, Col.

22, line 1-54. See also query loggers, Historical demand, previous transactions. For

example, Col. 24, line 62-Col. 25, line 34.

Peckover discloses that users may be authorized users and registered users.

Peckover permits persons and organization to become registered users. For example,

Col. 18, line 30-Col. 19, line 52. Peckover permits persons and organization to become

authorized users. For example, see Col. 21, line 13-67, Col. 25, lines 1-32.

Peckover discloses that parties may alternatively initiate offers and accept offers

as electronic transactions over one or more networks, such as the Internet. In

Peckover, parties may invoke electronic transactions among parties that are authorized

users of the system. Parties may be registered in various roles and capacities to (a) provide information, (b) access information provided by others and conclude commercial transactions. The various parties interact to complete buying and selling transactions.

Persons and organizations may register to become users of the system (for example, Fig. 2 and related text, Col. 15, line 65-Col. 17, line 27). Each party may connect to the network via various types of devices, such as wireless including wireless loops, personal computers, PDA's and other embodiments.

Peckover discloses selecting parties as targets for types of products. For example, see references to Target consumer, Col. 35, line 62-Col. 37, line 41.

Peckover refers to discounts, different prices, Col. 5, lines 1-13. See also special prices to distributors. For example, Col. 16, line 9-Col. 17, line 28. See references to price range. Prices are calculated (including discounts) to produce new prices, including final prices. Final prices are stored in the database as transactions with transaction numbers.

Peckover discloses that parties may download and fill out forms (such as applications for credit) presented by providers of information. Peckover discloses market categories such as real estate (see at least section entitled Market, Col. 22, line 57-Col. 23, line 67 and Col. 37, lines 1-40). Credit includes loans, bonds, charge-account obligation, and others.[3] A loan is a transaction wherein an owner of property

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[3] Definition of credit, Barron's Dictionary of Business Terms.

(lender) allows another party (the borrower) to use the property.[4] A mortgage is a debt instrument by which a borrower (a mortgagor) gives a lender (mortgagee) a lien on property as security for the repayment of a loan.[5]

Peckover *does not* specifically disclose

- that purchasing information associated with the data subject includes credit card information and shipping information, the shipping information including a shipping address and a preferred shipping method

- that new prices are based on shipping address and preferred shipping method

However these differences are not functionally involved in the steps recited. The steps would be performed the same regardless of the data.   Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include credit card and other information from a customer because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Peckover *does not* specifically disclose

- determining whether credit card information is accepted by a merchant.

- sending a summary of Consumer transactions to the Consumer.

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[4] Definition of Loan, Barron's Dictionary of Business Terms.

- sending authorized Merchant transactions to an authorized Merchant..

- sending a transaction confirmation message to the Consumer

Walker discloses purchase confirmation databases, payment databases, sending transaction data, and confirmation messages in an environment where customers may present offers, merchants may be authorized and customers may be registered. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Peckover, *Walker* and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose the claimed limitations. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Peckover, *Walker* and knowledge generally available to one of ordinary skill in the art at the time the invention was made to disclose determining whether credit card information is accepted, sending summaries of transactions to customers and to merchants, and sending confirmation messages to customers for the obvious reason that merchants often determine whether to accept credit cards when making a sale customers often rely on summaries of their transactions to balance their personal budgets, and merchants rely on summaries of transactions for auditing purposes.

Response to Arguments

Applicant's arguments filed 5 August 2004 have been fully considered but they are not persuasive.

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[5] Definition of Mortgage, Barron's Dictionary of Business Terms.

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant admits that Peckover "discloses a system for electronic commerce having personal agents that represent consumers and providers in a 'virtual marketplace.'" Nevertheless, applicant argues

> ...Peckover discloses a system which assists users in locating products for sale, but only *anticipates* that the sale may actually be consummated at some point in time in the future, i.e., "when secure electronic transactions are available." Other than this suggestion, Peckover is entirely silent on whether his system may actually be used to purchase items over a network. [emphasis in original]

Electronic commerce is commercial activity that takes place by means of connected computers.[6] The Examiner respectfully notes that applicant appears to avoid discussion of various types of payment mechanisms in electronic commerce. See, for example, Col. 1, line 12-Col. 12, line 41. See also references to invoicing,

As noted previously, an invoice is a bill prepared by a seller of goods or services and submitted to the purchaser; an invoice lists all items bought, together with amounts owed.[7] As noted previously, Peckover specifically describes that

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[6] Definition of *Electronic Commerce*, MICROSOFT Computer Dictionary.

[7] Definition of *Invoice*, Barron's Dictionary of Business Terms.

- offers and messages may be received from a consumer. For offers, see at least references to offers to sell and offers to buy, offers to buy in response to advertisements (at least Col. 23, lines 20-30, Col. 26, lines 40-67, Fig. 31 and related text, at least Col. 33, line 50-Col. 34, line 24).

- For messages, see at least references to delivery of messages (Summary, messaging function, Fig. 3A and related text).

- offers may be associated with a merchant. See, for example, references to offers to sell and offers to buy, Fig. 9A and related text, queries associated with7 agents, Fig. 8B and associated text, at least Col. 23, line 63-Col. 24, line19).

- messages may include a cookie. See, for example, Col. 6, lines 26-32.

In response to applicant's arguments against the Peckover and Walker individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that it would destroy Walker's functions to permit prices to change after an offer has been accepted, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Therefore, applicant's arguments are not persuasive.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 80-115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-123 of U.S. Patent No. 6,092,053/*Boesch*. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims (method, computer medium and system) refer to receiving customer request for merchants' offer, including an identifier, associating offers with a transaction number, registering customers, authorizing merchants, storing and sending information concerning purchasing transactions, calculating new (final) prices for items based on a customer's address, authenticating customers based on passphrase.

Boesch claims are directed to methods for receiving customer requests for a merchant offer, where the offer is associated with a transaction number. Customers' browsers include an identifier for dealing with registered customers. *Boesch* discloses storing information concerning purchasing transactions, calculating final price,

authenticating customers with a passphrase. *Boesch* also refers to label-value pairs that represent information that is necessary to identify the merchant and the merchant computer. Boesch does not specifically claim authorizing merchants.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine *Boesch* with knowledge generally available to one of ordinary skill in the art to disclose authorizing merchants and other entities. One of ordinary skill in the art at the time the invention was made would have been motivated to combine *Boesch* with knowledge generally available to one of ordinary skill in the art to disclose authorizing merchants and other entities for the obvious reason that such authorizing may reduce the number of bogus merchants and reduce the number of false and invalid offers to customers.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita
Patent examiner
Art Unit 3625
20 November 2004

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